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EXAMINER

MORGAN, G

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 08/979,567	Applicant(s) Shiota et al
Examiner George Morgan	Group Art Unit 2761

Responsive to communication(s) filed on Mar 11, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-27 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2761

## **DETAILED ACTION**

### *Status of Claims*

1. Claims 1-12 were under prosecution in this application at the time of the prior, November 12, 1998, Office Action. Applicant has amended Claims 1, 3, 6, 8, and 12, and added Claims 13-27, by amendment filed March 11, 1999. Therefore, Claims 1-27 are under prosecution in this application.

### *Summary of this Office Action*

2. Applicant's remarks filed March 11, 1999 have been fully considered, are discussed in the next section below or within the following rejection under 35 U.S.C § 103, and are not deemed to be persuasive. Therefore, Claims 1-27 are rejected under 35 U.S.C § 103 as unpatentable over the art cited below; and Applicant's request for allowance is respectfully denied.

### *Response to Applicant's Amendment*

3. Examiner acknowledges applicant's corrections to the specification in response to objections made with respect to minor informalities, and withdraws these objections from the record.

4. Examiner acknowledges applicant's correction to Claim 8, which was objected to as being a substantial duplicate of Claim 3, and withdraws this objection from the record.

5. Examiner acknowledges applicant's corrections to Claims 3, 8, and 12, which had been rejected to under 35 U.S.C. § 112, Second Paragraph, and withdraws these rejections from the record.

Art Unit: 2761

6. As regards Moghadam not disclosing "high resolution picture image data", the Examiner concedes as much, but maintains that "high resolution picture image data" was never claimed with respect to independent claims 1, 3, 6, 8, 11, and 12, as originally filed. Applicant argues that "Moghadam only transmits index files...and not the entire high resolution image picture. As a result, the user...in Moghadam is *not able to perform a wide variety of editing functions which can influence his print order* (emphasis in original)". Examiner agrees that "Moghadam only transmits index files...and not the entire high resolution image picture". However, this line of reasoning fails because "editing functions" were never claimed with respect to the independent claims. The claims as originally filed concern ordering photographic prints. This could include selecting photographs to be ordered from a display screen, and placing an order so that the photofinishing lab can fill the order. Editing of these photographic images was never claimed with respect to independent claims 1, 3, 6, 8, 11, and 12, as originally filed.

7. As regards the Applicant's introduction of "high resolution picture image data" into amended claims 1-27, the Examiner has included the reference "Photo Finishing on the Web" (from PC Magazine Online, dated September 17, 1996), which, in combination with Moghadam, teaches this limitation. The motivation for combining the "high resolution picture image data" of PC Magazine Online with the picture print order system of Moghadam would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

Art Unit: 2761

8. As regards to Cameron and PC Online, Applicant merely make unsupported assertions that these reference “fail to make up for the deficiencies of Moghadam”. This argument is deemed to be unpersuasive.

9. Applicant’s remaining traversals are discussed under the 35 U.S.C § 103 rejection below.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 5-8, 10, 12, 13-21, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of Cameron et al, U.S. Patent No. 5,592,378, and PC Magazine Online (“Photo Finishing on the Web”).

As per Claim 1, Moghadam discloses a picture print ordering system comprising the steps of recording picture image data obtained by reading a developed film (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing service which can be provided for the image data in a predetermined recording medium and displaying the printing service information and the image data recorded in the recording medium when the print ordering information is generated (see Figure 5, which shows printing service information that was recorded for a

Art Unit: 2761

customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and generating the print ordering information by using the displayed printing service information (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in "high resolution". *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print

Art Unit: 2761

order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

As per Claim 2, Moghadam discloses that the printing service information includes the sizes in which a print can be generated (see Figure 5 which displays the available sizes; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes). However, Moghadam does not expressly disclose that the printing service information includes the service charges therefor. Cameron teaches that service information may include the service charges therefor (see Figure 22 and 23, which illustrate service charges for a shirt). Further, PC Magazine Online teaches that customers may order picture prints from picture image data displayed to a customer (page 2, paragraphs 2-4). It would have been obvious to one skilled in the art at the time the invention was made to combine the use of service charges by Cameron and the picture print ordering capabilities of PC Magazine, in order to include picture service charges in the picture print information of Moghadam. The motivation would have been to allow customers to easily place orders knowing the different sizes that are available and the service charges.

Claims 7, 14, and 20 recite the same limitations as Claim 2, and are rejected for the same reasons.

As per Claim 3, Moghadam does not expressly disclose that the printing service information includes information regarding the available time period of the printing services.

Art Unit: 2761

However, Cameron teaches that a computerized order entry system can provide service information regarding the availability of services being offered (col. 17, line 60 to col. 18, line 8; explaining that the customer is told if the item is not in stock). It would have been obvious to one skilled in the art at the time the invention was made to incorporate the use of the information regarding the available time period of the printing services by Cameron into the printing service information of Moghadam. The motivation would have been to allow customers to place that could be filled.

Claims 8, 15, and 21 recite the same limitations as Claim 3, and are rejected for the same reasons.

As per Claim 5, Moghadam does not disclose that the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed. However, PC Magazine teaches that the printing service information can include information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed (page 2, paragraphs 2-4; explaining that the “PhotoNet” service includes information on reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent “over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.”) It would have been obvious to one skilled in the art at the time the invention was made to combine the finishing information taught by PC Magazine with the

Art Unit: 2761

printing service information of Moghadam. The motivation would have been to allow customers to make informed purchasing choices by knowing which finishing options existed.

Claims 10, 17, and 23 recite the same limitations as Claim 5, and are rejected for the same reasons.

As per Claim 6, Moghadam discloses a picture print ordering system comprising printing service information recording means which records picture image data obtained by reading a developed film (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing services which can be provided to the image data in a predetermined recording medium (see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and display means which displays the printing service information recorded in the recording medium and the image data when the print ordering information for requesting a printing service regarding the image data recorded in the medium is generated (see Figure 5, which shows printing service information that was recorded for a customer order being displayed); and print ordering information generating means which generates the print ordering information by using the displayed printing service information received by the input receiving means (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam discloses input receiving means which receives input of instruction information using the displayed printing

Art Unit: 2761

service information (see Figure 4, which shows input means, at 72 via telephone, at 62 via satellite; see Figure 5, which shows a terminal for entering instruction information regarding selection of the individual photographic images along with their respective sizes), he does not expressly disclose a “variety” of the instruction information. Cameron discloses a computerized order entry system for the placement of an ordering instructions for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; “A storage mechanism provides for the storing of offer information...”) and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders with a variety of instruction information for photographs.

Moghadam does not disclose that the picture image data is recorded in “high resolution”. *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to “send, download, and print high resolution photographs [page 1, second paragraph]”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

Art Unit: 2761

As per Claim 13, Moghadam discloses a picture print ordering method comprising the steps of: recording picture image data, obtained by reading a developed film, and printing service information regarding printing services, which can be provided for the picture image data, on a recording medium by a photo finishing system; displaying the printing service information and the picture image data from the recording medium at a user device, generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service information; displaying the printing service information and the picture image data from the recording medium at a user device; and, generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service information (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being

Art Unit: 2761

offered for sale (col. 2, lines 46-48; “A storage mechanism provides for the storing of offer information...”) and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in “high resolution”. *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to “send, download, and print high resolution photographs [page 1, second paragraph]”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

As per Claim 18, Moghadam discloses the steps of: recording the print order information on the recording medium at the user device, and supplying the recording medium to the photofinishing system to produce prints in accordance with the print order information (Figure 5 shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer

Art Unit: 2761

entering next to the respective image the selection choices. In order to fulfill the order, the recording medium would be sent to the photofinishing system. Fig. 4 illustrates the communication between the photofinishing center 50 and user 66 having access to personal computer 68 hooked up to telephone line 72. The "recording medium" would consist of the data packets being sent and received among the parties to effect the selection and order of photographs).

Claim 24 recites the same limitations as Claim 18, and is rejected for the same reasons.

As per Claim 19, Moghadam discloses a picture print ordering system comprising:

a first recording unit for recording picture image data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the picture image data on a recording medium by a photo finishing system; a display unit for displaying the printing service information and the picture image data from the recording medium at a user device; and generating unit for generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service information. (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and

Art Unit: 2761

displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; “A storage mechanism provides for the storing of offer information...”) and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in “high resolution”. *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to “send, download, and print high resolution photographs [page 1, second paragraph]”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

As per Claim 25, Moghadam discloses a photo finishing system comprising: an image data obtaining unit which obtains picture image data from a user; a print ordering information

Art Unit: 2761

obtaining unit which obtains print ordering information regarding the picture image data from the user; and a print generating unit which carries out a variety of printing processes based on the print ordering information, wherein the print ordering information is generated using printing service information and the picture image data displayed on a user device. (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; “A storage mechanism provides for the storing of offer information...”) and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Art Unit: 2761

Moghadam does not disclose that the picture image data is recorded in "high resolution".

*PC Magazine Online* teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

As per Claim 26, Moghadam discloses a computer program embodied on a computer-readable medium for ordering prints comprising: a recording source code segment for recording full image picture data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the picture image data on a recording medium by a photo finishing system; a displaying source code segment for displaying the printing service information and the picture image data from the recording medium at a user device; and a generating source code segment for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information. (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes;

Art Unit: 2761

see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam.

The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in "high resolution". *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher

Art Unit: 2761

quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

As per Claim 27, Moghadam discloses a medium comprising: a first recording area for recording picture image data; and a second recording area for recording information regarding printing services, wherein the picture image data and the information regarding printing services are provided together to a customer; the customer ordering a print out according to the information regarding printing services and the picture image data (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; “A storage mechanism provides for the storing of offer information...”) and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious

Art Unit: 2761

to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in "high resolution". *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

12. Claims 4, 9, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of Cameron et al, U.S. Patent No. 5,592,378, *PC Magazine Online* ("Photo Finishing on the Web"), and Cloutier et al, U.S. Patent No. 5,229,810.

As per Claim 4, Moghadam does not disclose that the printing service information includes information showing an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium. However, Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service information has been

Art Unit: 2761

recorded in the recording medium (see Figure 7, which shows “camera identification number,” i.e., an apparatus that recorded information on the recording medium, and “Lab ID,” i.e., a service provider). It would have been obvious to include this additional information with the printing service information disclosed in Moghadam. The motivation would have been to allow customers to feel much more comfortable placing orders by providing them with information as to who would be performing the service on their valuable photographs.

Claims 9, 16, and 22 recite the same limitations as Claim 4, and are rejected for the same reasons.

13. Claims 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of PC Magazine Online (“Photo Finishing on the Web”).

As per Claim 11, Moghadam discloses a photo finishing system comprising image data obtaining means which obtains picture image data (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film); print ordering information obtaining means which obtains print ordering information regarding the image data (see Figure 5; col. 6, lines 5-8 explains that an order is accomplished by the customer entering next to the respective image the selection choices; see Figure 4, which shows that ordering information may be obtained by the system via either telephone or satellite communication); and print generating means which carries out a variety of printing processing based on the print ordering information (see Figure 5; col. 6, lines 5-8 explains that an order is

Art Unit: 2761

generated by the customer entering next to the respective image the selection choices; the customer chooses which images to print and the sizes); wherein the print ordering information obtaining means obtains print ordering information having been generated by using printing service information and the image data displayed on a predetermined order screen as print services which can be provided for the image data (see Figure 5). Although Moghadam discloses that the print generating means carries out printing processing for providing the printing service displayed as the printing service information, based on the print ordering information (see Figure 5), he does not expressly disclose a “variety of printing processing.” PC Magazine teaches that the print generation means may carry out a variety of printing processing (see page 2, paragraphs 2-4; explaining that the “PhotoNet” service includes generating reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent “over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.”) It would have been obvious to one skilled in the art at the time the invention was made to combine the print processing taught by PC Magazine with the print processing means of Moghadam. The motivation would have been to provide photographs that could then be printed in a manner in which the customer found personally attractive.

Moghadam does not disclose that the picture image data is recorded in “high resolution”. *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to “send, download, and print high resolution photographs [page 1, second paragraph]”. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 2761

incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of PC Magazine Online ("Photo Finishing on the Web"), and Cloutier et al, U.S. Patent No. 5,229,810.

As per Claim 12, Moghadam discloses a program comprising the steps of displaying printing service information and image data of a picture image recorded in a predetermined recording medium on a display apparatus connected to a computer (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows picture images and print service information displayed on a terminal); enabling instruction information using the displayed printing service information to be input by input devices of the computer (col. 6, lines 5-8 explains that an order is accomplished by the customer inputting next to the respective image the selection choices; col. 5 lines 66-7 to col. 6 line 1 notes that the screen shown in Figure 5 could be either a home computer or the screen of a TV); and generating the print ordering information based on the instruction information input by the input devices (col. 6, lines 5-8). Although Moghadam discloses more than one type of input device, i.e., home computer and TV, he does not expressly disclose a "variety of input devices." Cloutier teaches that printing service information may be recorded on an magnetic strip which

Art Unit: 2761

can be read by an input device connected to a computer (col. 3 lines 39-55 summarizing his invention; Figure 2 shows that the read/write process is attached to a microprocessor). It would have been obvious to combine Cloutier's input device, along with other well known input devices, e.g., mouse, light pen, with Moghadam's input devices. The motivation would have been to provide a print ordering system that is more user friendly.

Moghadam does not disclose that the picture image data is recorded in "high resolution". *PC Magazine Online* teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by *PC Magazine Online* into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

#### *References Cited*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Brown et al (4,972,318) disclose an order entry and inventory control method capable of providing remote order entry for many different types of products, along with inventory control and order validation.

Art Unit: 2761

Jaskowsky (4,065,661) discloses a photofinishing apparatus for producing photographic prints and for printing a customer bill controlled by a computer.

Cloutier et al (5,130,745) disclose a transparent magnetic layer in a photographic film used for information exchanging among various user of the film, such as the film manufacturer, the camera user, the dealer, and the photofinisher.

*Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Morgan whose telephone number is (703) 306-2906. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m.

Art Unit: 2761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703) 305-9714. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*May 28, 1999*

D. M.



STEPHEN R. TKACS  
PRIMARY EXAMINER